

REMARKS

The application has been reviewed in light of the Final Office Action dated December 21, 2009. Claims 1-3 and 5-32 are currently pending in this application with claims 25-32 being withdrawn from examination. No amendments to the pending claims have been made.

Applicants acknowledge the withdrawal of the rejection under 35 U.S.C. §112 and the Examiner's consideration of IDS filed December 10, 2009.

Summary of February 17, 2010 Examiner Interview

On February 17, 2010, a telephonic Examiner Interview took place between Examiner Bijan Ahvazi of the U.S. Patent and Trademark Office and Michael Lin, applicants' representative. Applicants' representative requested the February 17, 2010 interview to discuss the rejections set forth in the December 21, 2009 Final Office Action issued in connection with the subject application.

During the February 17, 2010 telephone interview, Applicants' representative respectfully submitted that the anticipation rejection under §102(e) fails on several grounds.

First, Applicants' representative pointed out that the disclosure of Stark et al. relates to a method of producing metal oxides. On the other hand, the pending claims 1-3, 6, 9 and 18-21 are directed to a method of producing metal salts.

In addition, Applicants' representative pointed out that Stark et al. disclosed a genus of carboxylic acid with a mean carbon content of greater than 2 carbon atoms. Such genus does not teach the pending claims which are directed to a mean carbon number per carboxylate group of at least 3 for its cationic metal.

During the February 17, 2010 telephone interview, Applicants' representative also respectfully submitted that the obviousness rejection under §103 fails because the cited art only

qualifies as §102(e) prior art and both the cited art and the subject application, at the time the claimed invention was made, were subject to an obligation to assign to Eidgenossische Technische Hochschule Zurich. Applicants' representative pointed out that a statement indicating such obligation has already been made in Applicants' November 19, 2009 Amendment in Response to May 20, 2009 Office Action. The Examiner acknowledged the arguments presented by Applicants' representative and agreed that the obviousness rejection should be withdrawn.

Double Patenting

On pages 2 and 3 of the December 21, 2009 Final Office Action, the Examiner provisionally rejected claims 1-3 and 5-24 on the ground of nonstatutory obviousness-type double patenting as allegedly unpatentable over claims 1-19 of copending U.S. Serial No. 10/557,399 (mistakenly referred to as U.S. Serial No. 10/557,339 in the December 21, 2009 Final Office Action).

In response, Applicants note the Examiner's provisional double patenting rejection and will consider filing a terminal disclaimer once it is the only remaining rejection or once any of the copending applications is allowed with patentably indistinct claims.

Rejections under 35 U.S.C. §102(e) – Claims 1-3, 6, 9 and 18-21

On pages 4-6 of the December 21, 2009 Final Office Action, the Examiner rejected claims 1-3, 6, 9 and 18-21 under 35 U.S.C. §102(e) over Stark et al. (U.S. Patent Publication No. 2004/0126298).

In response, Applicants respectfully submit that Stark et al. do not teach every limitation of the pending claims 1-3, 6, 9 and 18-21.

First, Stark et al. is directed to a method of producing metal oxides. On the other hand, the pending claims 1-3, 6, 9 and 18-21 are directed to a method of producing metal salts. Nowhere in Stark et al. teaches that the method disclosed can be used to produce metal salts.

Moreover, Stark et al. teach that the metal oxide precursor is dissolved in a carboxylic acid solvent comprising a genus of carboxylic acid with a mean carbon content of greater than

2 carbon atoms. Pending claim 1 recites, on the other hand, a limitation of mean carbon number per carboxylate group of at least 3 for its cationic metal. A disclosure of a genus does not anticipate a claim to a species.

For the foregoing reasons, Stark et al. failed to teach every limitation of pending claims 1-3, 6, 9 and 18-21. Accordingly, Applicants respectfully request the Examiner reconsider and withdraw this rejection.

Rejections under 35 U.S.C. §103 – Claims 5-8, 10-14 and 22

On pages 6-9 of the December 21, 2009 Final Office Action, the Examiner rejected claims 5-8, 10-14 and 22 under 35 U.S.C. §103 over U.S. Patent Publication No. 2004/0126298 ('298 publication) and further in view of U.S. Patent Publication No. 2006/0229197 ('197 publication). The Examiner acknowledged that the evidence of common assignee between the '298 and '197 publications and subject application, provided in Applicants' November 19, 2009 Amendment in Response to May 20, 2009 Office Action ("November 19, 2009 amendment").

The Examiner is respectfully referred to Applicants' November 19, 2009 amendment. As discussed in Applicants' November 19, 2009 amendment, both the '298 and '197 publications can only qualify as prior art under 35 U.S.C. §102(e).

As indicated in Applicants' November 19, 2009 amendment, both the subject application and cited references, at the time the claimed invention was made, were subject to an obligation of assignment to Eidgenossische Technische Hochschule Zurich. Therefore, the cited references cannot be used in a rejection under 35 U.S.C. §103.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

Rejections under 35 U.S.C. §103 – Claims 15-17, 23 and 24

On pages 9 and 10 of the December 21, 2009 Final Office Action, the Examiner rejected claims 15-17, 23 and 24 under 35 U.S.C. §103 over U.S. Patent Publication No. 2004/0126298 and U.S. Patent Publication No. 2006/0229197 and further in view of Fujii et al. (U.S. Patent No. 4,659,617).

In response, as discussed in the above section relating to the rejection of claims 5-8, 10-14 and 22 under 35 U.S.C. §103, neither the '298 publication nor the '197 publication can

be used in a rejection under 35 U.S.C. §103.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

The Office is hereby authorized to charge any additional fees that may be required in connection with this amendment and to credit any overpayment to our Deposit Account No. 03-3125.

If a petition for an extension of time is required to make this response timely, this paper should be considered to be such a petition, and the Commissioner is authorized to charge the requisite fees to our Deposit Account No. 03-3125.

If a telephone interview could advance the prosecution of this application, the Examiner is respectfully requested to call the undersigned attorney.

Allowance of this application is respectfully requested.

Respectfully submitted,



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